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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,735	12/03/2003	Edgar V. Menezes	INT-0094-USA-DIV	6811
27777	7590	04/13/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 04/13/2004


Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/726,735

Applicant(s)

MENEZES, EDGAR V. 

Examiner

Jordan M. Schwartz

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/3/03 (Preliminary Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C.120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### ***Specification***

The specification is objected to for the following reasons:

1. In the "Brief Description of the Drawings", on page 2, line 11, it states, "Fig is an illustration..." but no Figure number is set forth. It is assumed to mean "Figure 1 is an illustration" and correction is required.

2. The "Brief Description" of Figure 4a is set forth twice (page 2, lines 20-21) and no "Brief Description" of Figure 4b is set forth. Correction is required.

### ***Claim Objections***

Claims 7-10, 12 and 15 (and dependent claims 11, 13-14) are objected to for the following reasons. Since the intended meaning could be determined from the specification and the Figures, 112 rejections were not made but instead these lack of clarity issues were raised in claim objections:

With respect to claim 7, claiming a “progressive addition surface” without claiming a lens creates a lack of clarity. The assumed meaning is a “progressive addition surface of a progressive addition lens” and it is suggested that applicant include this language within the first line of the claim to provide the required clarity.

With reference to claims 8-10, claiming “hard design” and “soft design” creates a lack of clarity since a design per se cannot be hard or soft. It is suggested that applicant change line 2 of these claims to state, “...surface designs is formed of a hard lens material, a soft lens material, or a combination thereof” to provide the required clarity.

With reference to claim 12, line 2, “the composite surface’s channel” lacks an antecedent basis and it is suggested that it be changed to “a composite surface’s channel” to provide the required clarity.

With reference to claim 15, lines 1-2, “the progressive surface and regressive surface design sag” lacks an antecedent basis and it is suggested that it be changed to “a progressive surface and regressive surface design sag” to provide the required clarity.

### ***Claim Rejections - 35 USC § 112***

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In reference to claim 15, the equation uses the term “I” which is not defined within either the specification or the claim and it is not known as to what this term means creating the lack of enablement.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claim 13 depends from claim 5, which has been cancelled rendering claim 13 vague and indefinite. It is assumed for purposes of examination that claim 13 meant to depend from claim 7.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

Claims 7-14 are rejected under 35 U.S.C. 102(d) as being anticipated by Japanese document number 2000-249992 (hereinafter referred to as "Japanese'992") and see Menezes U.S. patent number 6,139,148 which is an English translation of this document.

Japanese'992 reads on these claims by disclosing the limitations therein including the following: a method for designing a progressive addition lens (Menezes'148, column 1, line 40); comprising designing a progressive surface with at one least one area of unwanted astigmatism (Menezes'148, column 2, line 38); designing a regressive surface with an area of unwanted astigmatism (Menezes'148, column 2, line 38); combining the progressive and regressive surface designs to form a

composite surface design (Menezes'148, column 3, lines 1-3 with center portion of the lens having progressive and regressive surface layers as the "composite surface" similar to applicant's specification, page 7 third paragraph in which the "composite surface may be on the convex, concave, or both surfaces of the lens or in layers between these surfaces"). Japanese'992 further discloses the first and second areas of unwanted astigmatism as substantially aligned (Menezes'148, column 2, lines 54-67); each of the progressive surface designs are formed of either hard or soft lens material (column 3, line 9); the localized unwanted astigmatism less than about 0.125 diopters than the sum as claimed in claim 11 (Menezes'148, see examples); the composite surface having more than one area of localized unwanted astigmatism on each side of a composite surface's channel (column 3, lines 9-21); the designing surfaces expressed as sag departures from a base curve (column 3, line 35 to column 4, line 64). The base curvature will inherently be a concave or convex surface, this being reasonably based upon it being well known in the art of contact lenses for base curves to be non-planer i.e. either concave or convex.

### ***Examiner's Comments***

With reference to claim 7, as a suggestion to overcome the art rejection above, applicant may want to consider the following: in line 5 of the claim after "surface design," applicant may want to insert, "the composite progressive surface design formed on at least one of the front and back surfaces of the lens" since Japanese document number 2000-249992 discloses the progressive surface on one surface of the lens with the

regressive surface on the other surface of the lens or both surfaces in layers between the lens.

### ***Prior Art Citations***

European document number EP-1-026-533 is being cited herein to show a progressive lens that would have read on claims 7-14, similar to Japanese'992, however, such rejections would have been repetitive. Mukaiyama is being cited herein to show a progressive lens having some similar structure to that of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'JMS', with a large, stylized loop at the end.

Jordan M. Schwartz

Primary Examiner

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March 17, 2004